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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/20/2001

Steven O. Markel

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09/12/2005

EXAMINER

CHANG, SHIRLEY

OPTV/MOFO

C/O MORRISON & FOERSTER LLP

1650 TYSONS BOULEVARD, SUITE 300

MCLEAN, VA 22102

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,354

Applicant(s)

MARKEL, STEVEN O.

Examiner

Shirley Chang

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/20/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/26/01, 7/22/02  
7/2/03, 12/16/03, 12/31/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

***Detailed Action***

***Double Patenting***

Applicant is advised that should claim 7-10 be found allowable, claims 11-14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable by Blacketter et al. (2002/0056129) in view of Shintani et al. (2002/0095687).**

As to claim 1,

Blacketter et al. disclose: A method for delivering specific enhanced content to a set-top box whereby said content can be correctly utilized by said set-top box (fig. 1; [001-

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002]); receiving a trigger included in a video signal input at said set-top box that indicates enhanced content is available (fig. 3; [0031]). However, Blackketter does not disclose the steps of "establishing," "identifying", and "responding." However, Shintani teaches establishing a communication link between a server operated by a data service provider and said set-top box ('when a URL is found at 324, the URL is downloaded via the Internet 44...the scanning can take place any time prior to or during presentation of the interactive content to the viewers [0039]); identifying said set-top box through said communication link ('in any event, the STB 22 can have its own Universal Resource Locator (URL) or IP address or other unique identifier assigned thereto to provide for addressability by the head end and users of the internet' [0015]; in order to send content to a request by a STB involves identifying which STB made the request); responding by said server to said identification by transmitting said enhanced content to said set-top box; receiving enhanced data content by said set-top box for generation of enhanced display ('when a URL is found at 324, the URL is downloaded via the Internet 44' 'the scanning can take place any time prior to or during presentation of the interactive content to the viewers [0039]; 'the user selects the URL for downloading, and at 422 set-top box 22 sends a request to the service provider 10 for the page or other content associated with URL...the Content associated with the URL is sent to the set-top box at 438' [0042]). Accordingly, it would have been obvious to one skilled in the art to modify Blackketter et al. with Shintani for the purpose of 'providing a useful interactive experience to the user' [0003].

As to claim 2, Shintani et al. disclose:

wherein the said signal sent by the set-top box requests specific type content only ('the user selects the URL for downloading, and at 422 set-top box 22 sends a request to the service provider 10 for the page or other content associated with URL' [0042]).

As to claim 3, Shintani et al. disclose:

wherein the server responds to said signal set by said settop box and said server establishes identity of said set-top box and only transmits enhanced content specific to that type of said set-top box ('when a URL is found at 324, the URL is downloaded via the Internet 44' [0039]; 'the user selects the URL for downloading, and at 422 set-top box 22 sends a request to the service provider 10 for the page or other content associated with URL...the Content associated with the URL is sent to the set-top box at 438' [0042]).

As to claim 4, Blacketter et al. disclose:

Said trigger is located in the vertical blanking interval of the video signal input ("trigger 1200 is encoded in VBI line 21" [0052]).

As to claim 5, Blacketter et al. disclose:

version number 404 indicates an ATVEF trigger standard version number with which trigger 400 comports ([0036]).

As to claim 6, Blacketter et al. disclose:

wherein said communication link is Hyper Text Transfer Protocol (Hyper Text Transfer Protocol in figs. 4-6, elements 401, 501, and 601).

As to claim 7,

Blacketter in view of Shintani teach: A method for delivering specific enhanced content to a set-top box whereby said content can be correctly utilized by said set-top box comprising; receiving a trigger included in a video signal input at said set-top box that indicates enhanced content is available; establishing a communication link between a server operated by a data service provider and said set-top box; responding by said server to said signal by transmitting said enhanced content corresponding to said identity of said set-top box; receiving the enhanced data content by said set-top box for generation of an enhanced display (the limitations are included and met as discussed in claim 1). Although Blacketter does not specifically disclose "sending a signal from said set-top box to said server through said communication link; decoding a signal header by said server to establish said set-top box identity," Shintani teaches: the user selects the URL for downloading, and at 422 set-top box 22 sends a request to the service provider 10 for the page or other content associated with URL ([0042]); in any event, the STB 22 can have its own Universal Resource Locator (URL) or IP address or other unique identifier assigned thereto to provide for addressability by the head end and users of the internet ([0015]). Accordingly, it would have been obvious to one skilled in the art to modify Blacketter et al. with Shintani for the purpose of 'providing a useful interactive experience to the user' [0003].

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As to claim 8,

said trigger is located in the vertical blanking interval of the video signal input (met as discussed in claim 4).

As to claim 9,

said trigger is a command string written in Advanced Television Enhancement Forum compliant code (met as discussed in claim 5).

As to claim 10,

said communication link is Hyper Text Transfer Protocol (met as discussed in claim 6).

As to claim 11,

the limitations are included and met as discussed in claim 7.

As to claim 12,

said trigger is located in the vertical blanking interval of the video signal input (met as discussed in claim 4).

As to claim 13,

said trigger is a command string written in Advanced Television Enhancement Forum compliant code (met as discussed in claim 5).

As to claim 14,

said communication link is Hyper Text Transfer Protocol (met as discussed in claim 6).

As to claim 15,

Although Blackketter does not specifically disclose: "a system for delivering specific enhanced content to a set-top box whereby said content can be correctly utilized by said set-top box; a set-top box that receives a trigger encoded in a video signal indicating that enhanced content is available, and in response to said trigger sends a signal containing header information conveying identification and location information of said set-top box; a server that receives said signal and responds to said signal by transmitting enhanced content to said set-top box; wherein said a set-top box receives said enhanced content and generates an enhanced display," Shintani teaches the a system for delivering specific enhanced content to a set-top box whereby said content can be correctly utilized by said set-top box (fig. 1 and [001-002]); a set-top box that receives a trigger encoded in a video signal indicating that enhanced content is available, and in response to said trigger sends a signal containing header information conveying identification and location information of said set-top box (fig. 3, [0031]); a server that receives said signal and responds to said signal by transmitting enhanced content to said set-top box; wherein said a set-top box receives said enhanced content and generates an enhanced display (the limitations are included and met as discussed in claim 1). Accordingly, it would have been obvious to one skilled in the art to modify Blackketter et al. with Shintani for the purpose of 'providing a useful interactive experience to the user' [0003].

As to claim 16,



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wherein the said signal sent by the set-top box requests a specific type of content only (the limitations are included and met as discussed in claim 2).

As to claim 17,

wherein the server responds to said signal from said settop box and only transmits enhanced content specific to that type of said set-top box (the limitations are included and met as discussed in claim 3).

As to claim 18,

said trigger is located in the vertical blanking interval of the video signal input (met as discussed in claim 4).

As to claim 19,

said trigger is a command string written in Advanced Television Enhancement Forum compliant code (met as discussed in claim 5).

As to claim 20,

said communication link is Hyper Text Transfer Protocol (met as discussed in claim 6).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Xu et al. (2004/0073953) reference discloses an audio/video apparatus for use with a cable television network.
- The Drazin et al. (2004/0237108) reference discloses a system and method for providing an electronic program guide for television or radio programs.
- The Shusman (2004/0210947) reference discloses a method and apparatus for interactive video on demand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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